

### Remarks

Favorable reconsideration of this application is requested in view of the following remarks. For the reasons set forth below, Applicant respectfully submits that the claimed invention is allowable over the cited references.

The non-final Office Action dated July 1, 2004, indicated that the Specification is objected to; claims 1, 14 and 15 are rejected under 35 U.S.C. § 103(a) over *Phaneuf et al.* (U.S. Patent No. 6,288,393) in view of *Sandhu et al.* (U.S. Patent No. 5,196,353); claims 1-6, 8, 11 and 14-20 are rejected under 35 U.S.C. § 102(e) over *Phaneuf*; claims 7, 9 and 10 are rejected under 35 U.S.C. § 103(a) over *Phaneuf* in view of *Lee* (U.S. Patent No. 6,403,439); and claims 12 and 13 are rejected under 35 U.S.C. § 103(a) over *Phaneuf*.

With respect to the Specification, Applicant has amended the Brief Description of the Drawings to include a description of FIGs. 5 and 6, as well as to correctly identify the description of FIG. 7. The Specification has also been amended to correctly identify the filing date of the cross-referenced patent application at page 6. Applicant submits that these changes overcome the stated objections and requests that the objections be removed.

Applicant respectfully traverses the Section 102(e) rejection because the Office Action fails to present a reference that corresponds to the claimed invention. The Office Action fails to identify where the '393 reference teaches the claimed limitations directed to simultaneously recording a plurality of images and removing substrate. The cited portions, as well as the remainder of the '393 reference, teach first exposing a layer and then imaging the layer. This '393 method of imaging would appear to be non-simultaneous. *See* column 6, lines 13-34. While this "simultaneously" limitation has been removed in the above amendments, thereby broadening the claims, the '393 reference still fails to correspond to the now-amended claims.

Applicant has amended each of the independent claims to further characterize that the analysis is directed toward a suspected defect. The '393 reference fails to teach exposing a suspected defect in a die, and further, teaches away from such limitations. The Office Action acknowledges at page 4, paragraph 17, that the '393 reference does not disclose exposing a defect in the die. Rather, the '393 reference is directed to reverse engineering a die to ascertain its intended operation, and more specifically to removing layers to determine the intended circuit design of the die. Moreover, consistent with the

assignee's business, the '393 reference clearly teaches this intended application. *See* column 4, line 62 – column 5, line 5. The proposed modification teaches away from this intended purpose because it changes the die under consideration to a defective die that is no longer operating as intended. Therefore, the '393 teachings could not be used to ascertain the die's intended operation and/or circuit design. Accordingly, Applicant requests that the Section 102(e) rejection be withdrawn.

Applicant respectfully traverses the Section 103(a) rejection of claims 7, 9 and 10 because the proposed modification of the '393 reference would frustrate the purpose and operation of the '393 reference. The MPEP states that when a proposed modification would render the teachings being modified unsatisfactory for their intended purpose, then there is no suggestion or motivation to make the proposed modification under 35 U.S.C. § 103(a). *See* MPEP § 2143.01. As discussed above, a skilled artisan would not modify the '393 teachings to remove substrate to expose a defect because he would not even be working with a die having suspected defects. Such a modification goes against the teachings of the '393 reference and would undermine the purpose of the '393 reference. Applicant accordingly requests that the rejection be withdrawn.

With particular respect to the Section 103(a) rejection of claims 12 and 13, Applicant respectfully traverses the Official Notice taken at page 5 because it is unclear that the skilled artisan would edit the '393 image to view a portion exhibiting a defect. As discussed above, the '393 reference does not teach a die having such a defect. *See* MPEP § 2144.03.

Applicant respectfully traverses the Section 103(a) rejection of claims 1, 14 and 15, at page 2 because no reasons for rejection have been presented. Consistent with 35 U.S.C. § 132, the Office Action must provide rationale for the stated rejection. Without further explanation, Applicant submits that the rejection is improper and must be withdrawn.

Consistent with the above discussion, Applicant also traverses the characterization of the art made of record but not relied upon at page 6 of the Office Action. However, because this art was not used in connection with any of the rejections, Applicant submits that any such mischaracterization is moot and would require no further discussion.

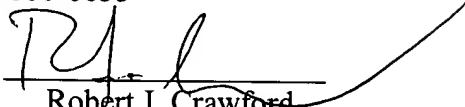
In view of the remarks above, Applicant believes that each of the rejections has been overcome and the application is in condition for allowance.

Should there be any remaining issues that could be readily addressed over the telephone, the Examiner is encouraged to contact the undersigned at (651) 686-6633.

Respectfully submitted,

CRAWFORD MAUNU PLLC  
1270 Northland Drive, Suite 390  
St. Paul, MN 55120  
651/686-6633

Dated: September 10, 2004

By:   
Robert J. Crawford  
Reg. No. 32,122